

Appl. No. : 09/993,874  
Filed : November 14, 2001

### REMARKS

Claims 12-14 have been added. Support for the amendment can be found at page 5, lines 12-16, and page 33, lines 7-19, for example. No new matter has been entered thereby. Claims 1, 7, 8, and 12-14 are pending. Applicant respectfully requests entry of the amendments and reconsideration of the application in view of the amendments and of the following remarks.

#### Claim Rejections – 35 U.S.C. § 112, First Paragraph

The remaining issue is whether adding the term “approximately” in Claim 1 is considered to be a new matter.

In the Response to Advisory Action dated September 14, 2004, Applicant respectfully submitted that, in focusing too narrowly on the text of the originally-filed specification and specifically on the absence of the words “a maximum  $\lambda$  of approximately 549 nm” in that specification, the Examiner overlooked the clear support for the claim limitation present in originally-filed Figure 3.

The court held that that drawing alone was sufficient support for the claimed limitation. Cooper Cameron, 291 F.3d at 1319-20. In the present case, as in Cooper Cameron, Applicant has described the invention in two ways: one set forth in haec verba in the text of the specification, and one that the skilled artisan would understand from a drawing together with textual references. The Examiner has, like the district court judge in Cooper Cameron, recognized only the former, and has rejected a claim limitation directed to the latter as lacking written description support. Applicant submits that under Cooper Cameron, the Examiner’s rejection is untenable, and respectfully requests that the rejection of the pending claims for lack of written description support be withdrawn.

In the Second Advisory Action, the Examiner asserts:

“The terms ‘equal’ and ‘approximately’ have different meaning. Furthermore, one skilled in the art would not glean from Figure 3 that maximum is at approximately 549 nm and not at approximately 548 nm, for example, because the X-axis is not graduated in a way to render the conclusion.”

However, in the above, the Examiner fails to consider the text of the specification which states “549 nm”. As the Examiner points out, “one skilled in the art would not glean from Figure

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3 that maximum is at approximately 549 nm and not at approximately 548 nm, for example, because the X-axis is not gradated in a way to render the conclusion.” However, because the text of the specification states “549 nm”, in combination with Figure 3, one skilled in the art would certainly think that the maximum is at “approximately 549 nm”, rather than “approximately 548 nm”. Applicant does not assert “approximately 549 nm” based solely on Figure 3, but in combination with the text of the specification. The Examiner appears to consider the text of the specification separately from the drawings. The text of the specification states “549 nm,” and the X-axis of Figure 3 is not gradated in a way to render the conclusion that the maximum is at 549 nm. Thus, in view of both the text of the specification and Figure 3, adding the term “approximately” before “549 nm” should not be considered to be a new matter.

Applicant respectfully requests withdrawal of this rejection.

#### New Claims

Claims 12-14 have been added. Claim 12 corresponds to Claim 1 but specifies the measuring conditions. As explained in the specification (page 33), the bioluminescence spectra were determined using a Hitachi F4500 spectrofluorometer. If another device is used, the maximum could be slightly different. The rejection of Claim 1 does not apply to Claim 12, and it is respectfully submitted that Claim 12 and dependent Claims 13 and 14 are allowable.

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**CONCLUSION**

In light of the Applicant's amendments to the claims and the foregoing remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: November 10, 2004

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